

## REMARKS/ARGUMENTS

### *Status of the Application*

In the Final Office Action mailed May 19, 2006, and the Advisory Action mailed August 31, 2006, claims 1-13 were rejected. In the present response, no amendments to the claims were made. Thus, claims 1-13 are pending. No new matter was added.

### *Rejections Under 35 U.S.C. §§ 102(e), 103(a)*

Claims 1-13 were rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Stengel *et al.* (U.S. Patent No. 6,458,885). Applicants respectfully traverse these rejections.

Applicants have met their burden of establishing novelty and nonobviousness of their claimed invention over Stengel *et al.*

Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product.

MPEP § 2113, 3rd ¶ (citing *In re Marosi*, 710 F.2d 798, 802 (Fed. Cir. 1983)). In the previous responses to office actions filed on March 14, 2006, and August 16, 2006, Applicants explained in detail the differences between the *product* of their claimed invention and the Stengel *et al.* coating composition. Applicants have thus come forward with evidence establishing nonobvious differences between their claimed product and the coating composition of Stengel *et al.* In the Advisory Action, the Examiner apparently recognizes this fact by stating that “Applicants’ [sic] provide the evidence of structural difference of the product from the prior art reference Stengel *et al* (US006458885B1).” Yet, the Examiner sustained the final rejection, stating that “[s]ince applicants’ claim 1 is composition claim [sic] with two components and process [sic] further limiting component A . . . , the disclosure of coating composition [sic] by Stengel *et al* . . . meet [sic] the composition requirements of applicants’ claim 1.” (internal citations omitted). These statements are contradictory. Because Applicants have provided evidence of structural and functional differences between their claimed product and that of Stengel *et al.*, the coating composition of Stengel *et*

*al.* cannot anticipate or make obvious Applicants' claimed invention. Applicants thus respectfully request withdrawal of the rejection.

Apparently the interpretation of Applicants' claim 1 used to invalidate the claim is that Applicants' claimed invention is merely a coating composition comprising (A) at least one hydroxy-functional (meth)acrylic copolymer having an OH value from 160 to 200 mg KOH/g and a weight average molecular weight Mw from 2,500 to 30,000 and (B) at least one polyisocyanate cross-linking agent. If this is indeed the conclusion reached by the Examiner, it is a vast oversimplification of the claim as well as the process of determining the patentability of product-by-process claims. Such an interpretation ignores the USPTO's basic rule for product-by-process claims, namely, that a product-by-process claim is novel and nonobvious if the *product* thereof is novel and nonobvious. See MPEP § 2113, 1st ¶ ("Even though product-by-process claims are limited by and defined by the process, determination of the patentability is based on the product itself.") (quoting *In re Thorpe*, 777 F.2d 695, 698 (Fed. Cir. 1985)). Applicants' product is not merely defined as having components (A) and (B), but rather is one having the properties described in Applicants' specification and in the responses to office actions, properties which arise because of the process described in the claim. Because Applicants have met their burden of establishing that this *product* of their claim 1 invention is novel and nonobvious over Stengel *et al.*, the claim should be allowable.

**SUMMARY**

In view of the foregoing remarks, Applicants submit that this application is in condition for allowance. In order to expedite disposition of this case, the Examiner is invited to contact either of Applicants' representatives at the telephone numbers listed below to resolve any remaining issues. Should there be a fee due which is not accounted for, please charge such fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

Respectfully submitted,

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Dated: November 14, 2006